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CASENOTES

SHAW v. LINDHEIM:¹ THE NINTH CIRCUIT'S ATTEMPT TO EQUALIZE THE ODDS IN COPYRIGHT INFRINGEMENT.

I. INTRODUCTION

"When the scales of justice are unbalanced, the Equalizer sets them straight."² While this may be an accurate description of the lead character in the television series, *The Equalizer*, it does not describe the current state of affairs in the Ninth Circuit for copyright infringement suits. The Ninth Circuit has failed to balance the scales of justice for copyright infringement actions because it has not created a viable framework for adjudicating such actions. To maintain a successful claim for copyright infringement, the plaintiff must demonstrate that the alleged infringer has taken an improper amount of the plaintiff's copyrighted work.³ This is known as the requirement of substantial similarity.⁴ For decades, the Ninth Circuit has attempted to articulate a viable test for determining whether one work is substantially similar to another to constitute infringement.

The Ninth Circuit recently addressed this problem in *Shaw v. Lindheim*⁵ when it reformulated the traditional two-part test for substantial similarity.⁶ The primary inquiry in *Shaw* was whether substantial similarity existed between the plaintiff's script and the defendants' pilot script to constitute a triable issue on the claim for copyright infringement.⁷ In *Shaw*, Columbia Broadcasting System ("CBS") produced the weekly television series, allegedly created by Richard Lindheim ("Lindheim") and Michael Sloan ("Sloan"), entitled *The Equalizer*.⁸ The plaintiff, Lou Shaw ("Shaw"), contended that CBS obtained *The Equalizer* storyline after he had submitted his script, *The Equalizer*, to defendant

1. 908 F.2d 531 (9th Cir. 1990).

2. *The Equalizer* (USA Cable Network, October 15, 1990).

3. M. LEAFFER, UNDERSTANDING COPYRIGHT LAW, § 9.2, at 266 (1989).

4. *Id.*

5. 908 F.2d 531 (9th Cir. 1990).

6. This two-part test was developed in *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977) and will be discussed in the latter portion of this note.

7. *Shaw v. Lindheim*, 908 F.2d 531 (9th Cir. 1990).

8. *Id.* at 533.

Lindheim as the head of the National Broadcasting Company's ("NBC") Dramatic Programming Department.⁹ Despite the strong similarities between Shaw's script and the defendants' pilot script, the district court granted the defense's motion for summary judgment on Shaw's claim for copyright infringement.¹⁰ Thereafter, the Ninth Circuit reversed and thereby enunciated a new rule for determining copyright infringement as a matter of law.¹¹

This note examines the flaws of the *Shaw* rule, particularly its failure to distinguish between the separate forms of substantial similarity as they apply to infringement actions: substantial similarity as an element of permissible copying and substantial similarity as a second element of copyright infringement, also referred to as unlawful appropriation.¹² This examination demonstrates that the *Shaw* rule fails to preserve the tenuous balance between protection necessarily afforded to authors under the Copyright Act and the freedom of others to create works outside the area protected against infringement. Finally, this note recommends an alternative approach the Ninth Circuit should have adopted to provide a more viable framework for analyzing infringement actions.

II. STATEMENT OF THE FACTS

*Shaw v. Lindheim*¹³ involved an embittered battle between two screen writers wherein Lou Shaw claimed that Richard Lindheim misappropriated his script entitled *The Equalizer*.¹⁴ Lou Shaw is a successful writer and producer in the entertainment industry.¹⁵ During the 1976-1977 television season, Shaw had eight network television programs on the air. These programs were: *Quincy*, *Nancy Drew*, *McCloud*, *Columbo*, *Switch*, *Maude*, *Six Million Dollar Man*, and *Barnaby Jones*.¹⁶

The instant dispute began in February of 1978, when Shaw entered into an option contract with Lindheim regarding *The Equalizer*.¹⁷ At that time, Lindheim was an executive in the Dramatic Programming Division of NBC.¹⁸ The contract granted NBC the option of developing

9. *Id.*

10. *Id.*

11. *Id.* at 537. Basically, the court held that satisfaction of the extrinsic prong of the *Krofft* test creates a triable issue for copyright infringement claims. *Shaw*, 908 F.2d at 537.

12. *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946).

13. 908 F.2d 531 (9th Cir. 1990).

14. *Id.* at 533.

15. *Id.*

16. *Id.* at 533 n.1.

17. *Id.* at 533.

18. *Shaw v. Lindheim*, 908 F.2d 531, 533 (9th Cir. 1990).

Shaw's *The Equalizer* script into a television series.¹⁹ Accordingly, in July of 1978, Shaw delivered his script to Lindheim.²⁰ However, because NBC declined to produce *The Equalizer* as a weekly television series, all rights in the script reverted back to Shaw.²¹

In 1979, Lindheim left NBC and began working for Universal Television ("Universal").²² In 1981, during his employment with Universal, Lindheim allegedly authored a television series pilot which was also entitled *The Equalizer*.²³ Lindheim nevertheless admitted that he copied the title of his pilot from Shaw's script.²⁴ In 1982, Lindheim's pilot was subsequently revised and supplemented through the efforts of another author, Michael Sloan.²⁵ This revised script ultimately became *The Equalizer* television series featured on CBS beginning in 1985.²⁶

On November 19, 1987 Lou Shaw filed suit for copyright infringement and unfair competition against Lindheim, Sloan and other related parties.²⁷ In his claim for copyright infringement, Shaw alleged that the defendants' pilot script was substantially similar to his script, *The Equalizer*, that he had previously submitted to and had reviewed by Lindheim.²⁸ In response, the defendants moved for summary judgment.²⁹

III. THE COURT'S HOLDING

The district court held that reasonable minds could conclude that

19. *Id.*

20. *Id.*

21. *Id.*

22. *Id.*

23. Shaw v. Lindheim, 908 F.2d 531, 533 (9th Cir. 1990).

24. *Id.*

25. *Id.*

26. *Id.*

27. Shaw v. Lindheim, 908 F.2d 531, 533 (9th Cir. 1990). Although Shaw asserted two causes of action, this note will only address that for copyright infringement. Shaw also appealed the district court's grant of summary judgment on his claim that the defendants violated section 43(a) of the Lanham Act, 15 U.S.C. § 1125 (a). *Id.* at 542. Under section 43(a), a person is liable for using a false description of origin in connection with any goods or services put into commerce. *Id.* at 541-42 (citing 15 U.S.C. § 1125(a) (1988)). The district court dismissed Shaw's claim under the Lanham Act based on its finding that there was no substantial similarity between Shaw's script and the defendants' pilot. *Id.* at 542.

On appeal, Shaw contended that the "false designation of origin" language in the Lanham Act includes instances where defendant has copied a product and committed "reverse passing off" by selling it under his own label. *Id.* at 542. Despite the Ninth Circuit's finding of substantial similarity between the works, it nonetheless affirmed the district court's dismissal of Shaw's Lanham Act claim. *Id.* The court's decision was based primarily on the fact that the Copyright Act provided Shaw with an adequate remedy. *Id.*

28. Shaw v. Lindheim, 908 F.2d 531, 533 (9th Cir. 1990).

29. *Id.*

the two scripts were substantially similar as to the objective characteristics of theme, plot, sequence of events, characters, dialogue, setting, mood and pace.³⁰ This finding was based on the district court's analysis under the "extrinsic" prong of the *Krofft* test,³¹ traditionally employed to compare similarity of ideas.³² Nevertheless, the court further found that no reasonable jury could determine that the works had a substantially similar total concept and feel.³³ This finding was based on the court's analysis under the "intrinsic" prong of the *Krofft* test, traditionally used to compare similarity of protectable expression.³⁴ Consequently, the district court granted the defendants' motion for summary judgment.³⁵

The Ninth Circuit reversed the district court's grant of summary judgment in favor of the defendants.³⁶ The court held that it is improper for a court to find that there is no substantial similarity as a matter of law where the author has satisfied the "extrinsic" prong of the *Krofft* test.³⁷ Consequently, the Ninth Circuit announced a new rule for copyright infringement determinations: "that satisfaction of the extrinsic test [alone] creates a triable issue of fact in a copyright action involving a literary work"³⁸

IV. BACKGROUND

A. Underlying Purposes of Copyright Law

Authorities note that one of the primary goals of copyright law is "to promote the 'progress of science and useful arts' by protecting the labors of those who create original works and thereby ensuring the profitability of their endeavors and their willingness to bring novel ideas to the public."³⁹ This goal is implemented by the extension of copyright protection against infringement and the legal remedies available to authors

30. *Id.* at 535.

31. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977). This test will be discussed more fully in the latter sections of this note.

32. *Id.*

33. *Shaw v. Lindheim*, 908 F.2d 531, 535 (9th Cir. 1990).

34. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

35. *Shaw v. Lindheim*, 908 F.2d 531, 536 (9th Cir. 1990).

36. *Id.* at 541.

37. *Id.* at 537.

38. *Id.* Traditionally, the Ninth Circuit required the plaintiff to demonstrate a triable issue of substantial similarity under both the extrinsic and intrinsic prongs of *Krofft*. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

39. *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1357 (N.D. Ill. 1989) (quoting *Sony Corp v. Universal City Studios, Inc.*, 464 U.S. 417, 428-29 (1984)).

to prevent and punish infringements.⁴⁰

Conversely, courts have also recognized that too much protection "can deter the creation of new works if [individuals] are fearful that their creations will too readily be found to be substantially similar to pre-existing works."⁴¹ In other words, if authors could remove general ideas from the public domain by using them in published works, they would stifle rather than advance the development and exploitation of new ideas.⁴² Such a result is likely since overprotection would narrow the field of thought available for use in the development of creative, copyrightable works. Therefore, copyright protection must be closely monitored to allow authors "to experience the necessary encouragement to create while allowing society use of the conceptual subject matter upon which the creation is based."⁴³

To accommodate these divergent interests, courts have developed what is commonly referred to as the "idea-expression dichotomy."⁴⁴ The basic premise underlying the idea-expression dichotomy is that copyright protection extends only to protectable forms of expression embodied in a copyrighted work.⁴⁵ As Judge Learned Hand announced in *National Comics Publications, Inc. v. Fawcett Publications*:⁴⁶ "[A] copyright never extends to the 'idea' of the 'work,' but only to its 'expression,' and . . . no one infringes, unless he descends so far into what is concrete as to invade that 'expression.'"⁴⁷ In addition, Congress has codified the idea-expression dichotomy in the current Copyright Act as follows: "In no case does copyright protection for an original work of authorship extend to any *idea*, procedure, [or] process"⁴⁸

While this dichotomy is imprecise, it is a useful analytical tool for distinguishing infringing from non-infringing works, especially where the allegedly infringing work is accused of what Professor Nimmer called

40. See *Recent Developments, Substantial Similarity Between Video Games: An Old Copyright Problem in a New Medium*, 36 VAND. L. REV. 1277, 1286 (1986).

41. *Warner Bros. v. American Broadcasting Co.*, 720 F.2d 231, 240 (2d Cir. 1983).

42. See 3 M. NIMMER, NIMMER ON COPYRIGHT, § 13.03[A] (1990) [Hereinafter referred to as NIMMER ON COPYRIGHT].

43. S. Knowles & R. Palmieri, *Dissecting Krofft: An Expression of New Technology in Copyright*, 8 SAN FERN. V.L. REV. 109 (1980).

44. *Warner Bros. v. American Broadcasting Co.*, 720 F.2d 231, 240 (2d Cir. 1983).

45. See *Recent Developments*, *supra* note 40, at 1280 (citing *Mazer v. Stein*, 347 U.S. 201, 217 (1954)).

46. 191 F.2d 594 (2d Cir. 1951).

47. *Id.* at 600.

48. 17 U.S.C. § 102(b) (1976) (emphasis added).

"comprehensive nonliteral similarity."⁴⁹ Infringement which constitutes nonliteral similarity occurs where the fundamental essence or structure of a work has been duplicated.⁵⁰ Accordingly, as demonstrated below, the modern expansion of copyright protection requires principles such as the idea-expression dichotomy to define the scope of copyright protection while maintaining the goals underlying copyright law. Courts have come to rely on this idea-expression dichotomy in developing judicial tests for substantial similarity between works.

B. Expansion of Copyright Protection

Historically, copyright law only afforded protection against literal copying of an author's copyrighted work.⁵¹ However, under current copyright law, near identity of the works at issue is no longer necessary to establish copyright infringement.⁵² As the Ninth Circuit recognized in *Universal Pictures Co. v. Harold Lloyd Corp.*:⁵³

[A]n infringement is not confined to literal and exact repetition or reproduction; it includes also the various modes in which the matter of any work may be adopted, imitated, transferred, or reproduced, with more or less colorable alterations to disguise the piracy.⁵⁴

To establish a successful claim for copyright infringement today, the Ninth Circuit requires a plaintiff to prove: (1) ownership of a valid copyright and (2) "copying" of protectable expression by the defendant.⁵⁵

Under the 1976 Copyright Act, registration of the work with the copyright office constitutes "prima facie evidence of the validity of the copyright."⁵⁶ Thus, to demonstrate ownership of a valid copyright, one need only register his or her work with the United States Copyright office. Next, because direct proof of "copying" is rarely available, a plaintiff may establish copying by circumstantial evidence of: (1) defendant's access to the copyrighted work, prior to the creation of the defendant's work and (2) substantial similarity of both general ideas and expression

49. *Warner Bros. v. American Broadcasting Co.*, 720 F.2d 231, 240 (2d Cir. 1983) (citing 3 M. NIMMER, *NIMMER ON COPYRIGHT*, *supra* note 42, § 13.03[A][1]).

50. *Id.*

51. E. Samuels, *The Idea-Expression Dichotomy in Copyright Law*, 56 TENN. L. REV. 321, 325 (1989).

52. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1167 (9th Cir. 1977).

53. 162 F.2d 354 (9th Cir. 1947).

54. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1167 (9th Cir. 1977) (quoting *Universal Pictures*, 162 F.2d at 360 (9th Cir. 1947)).

55. *Id.* at 1162.

56. 17 U.S.C. § 410(c) (1976).

of those ideas between the copyrighted work and the defendant's work.⁵⁷ For the works to be substantially similar, the defendant must have copied a substantial and material amount of the plaintiff's protectable expression.⁵⁸

This last concept, substantial similarity of protectable expression and unprotectable ideas, has proven to be the most elusive concept in copyright law. As Professor Nimmer⁵⁹ emphasized: "The determination of similarity which will constitute a substantial and hence infringing similarity presents one of the most difficult questions in copyright law"⁶⁰ Therefore, courts have relied on the traditional idea-expression dichotomy in developing judicial tests for substantial similarity.

C. Judicial Tests for Substantial Similarity

The emergence of the idea-expression distinction engendered a continual struggle by courts to establish workable standards for determining when copying is sufficiently substantial to constitute infringement. The traditional ordinary observer test alone does not provide the analytic basis needed to distinguish between similarity from copying of expression and similarity due to non-copyrightable materials. As a result, courts have looked to a framework which uses the ordinary observer test, but which avoids its limitations.⁶¹

1. The *Arnstein* Test

Most judicial tests for substantial similarity stem from the traditional ordinary observer or audience test:

The question . . . in such comparison is to ascertain the effect of the alleged infringing [work] . . . upon the average reasonable man. If an ordinary person who has recently read the story sits through the presentation of the picture, if there has been literary piracy of the story, he should detect that fact without any aid or suggestion or critical analysis by others. The reaction of the public to the matter should be spontaneous and immediate.⁶²

57. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

58. M. LEAFFER, *UNDERSTANDING COPYRIGHT LAW*, § 9.5, at 268 (1989).

59. The late Professor Nimmer is a well known scholar in the field of intellectual property and the first amendment.

60. NIMMER ON COPYRIGHT, *supra* note 42, § 13.02[C], at 13-23.

61. M. LEAFFER, *UNDERSTANDING COPYRIGHT LAW*, § 9.6, at 274 (1989).

62. NIMMER ON COPYRIGHT, *supra* note 42, § 13.03[E], at 13-62.3-62.4 (quoting *Harold Lloyd Corp. v. Witwer*, 65 F.2d 1, 18 (9th Cir. 1933)).

One of the earliest modifications of the ordinary observer test was developed by the Second Circuit in *Arnstein v. Porter*.⁶³ The *Arnstein* test for substantial similarity is divided into two stages.⁶⁴ Under the first stage of the infringement analysis, the two works are compared, in their entirety, to determine if there is substantial similarity between both protectable and unprotectable components of the works.⁶⁵ That is, the factfinder must determine whether the two works are sufficiently similar to constitute permissible copying.⁶⁶ Expert testimony and analytic dissection may be employed to assist the factfinder in this determination.⁶⁷

Under the second stage of the infringement analysis, the factfinder must determine whether the alleged infringer's copying went so far as to constitute infringement. Copying only trivial aspects of another's work will not result in a finding of substantial similarity; infringement occurs only when the copying is sufficiently extensive.⁶⁸ The test employed here is as follows: "[W]hether defendant took from plaintiff's works so much of what is pleasing to the [senses of the lay consumer], who comprise the audience for whom [the work was created] that defendant wrongfully appropriated something which belongs to the plaintiff."⁶⁹ The ultimate determination of unlawful appropriation depends upon whether substantial similarity exists between the protectable expression within both works.⁷⁰ Because this determination depends upon the response of the lay listener, expert testimony and analytic dissection are generally disfavored here.⁷¹

63. 154 F.2d 464, 473 (2d Cir. 1946). This test has been labeled the Audience Test.

64. *Id.* at 468. To avoid confusing the separate elements essential to a plaintiff's suit for copyright infringement, the *Arnstein* court divided the issue of substantial similarity into two separate elements: (1) that defendant copied from the plaintiff's copyrighted work (permissible copying) and (2) that the copying (once proven) went so far as to constitute improper appropriation (illicit infringing copying). *Id.*

65. *Id.*

66. *Id.*

67. *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946). Analytic dissection is achieved by breaking down the works and comparing their elements.

68. See NIMMER ON COPYRIGHT, *supra* note 42, § 13.03[A][1] at 13-25-26 (Where the defendant copied not merely the general idea, but the expression of those ideas contained in the plaintiff's work, the two works are substantially similar and infringement may be found.).

69. *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946).

70. Note, *Facing The Nation: The Standards For Copyright, Infringement, and Fair Use of Factual Works* 134 U. PA. L. REV. 519, 564-65 (1986).

71. *Id.* at 558 (citing *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946)). The *Arnstein* court noted that expert testimony may be used to aid the jury in reaching its conclusion as to the response of a lay audience. *Id.*

2. The *Krofft* Test

Building upon the *Arnstein* test, the Ninth Circuit developed a two-part test for substantial similarity in *Sid & Marty Krofft Television Productions v. McDonald's Corp.*⁷² The first step in the *Krofft* analysis employs a so-called extrinsic test.⁷³ Under this test, the works are extrinsically compared to determine if there is substantial similarity of ideas forming the foundation of both works.⁷⁴ Since the nature of this test is extrinsic, expert testimony and analytic dissection may be employed to assist the trier of fact.⁷⁵ According to *Krofft*, substantial similarity must be demonstrated under the extrinsic test before the trier of fact examines substantial similarity under the intrinsic test.⁷⁶ Thus, if a court does not find substantial similarity when it applies the extrinsic test, the intrinsic test is never applied and no infringement may be found.⁷⁷

The second step of the *Krofft* analysis employs an intrinsic test.⁷⁸ Under this prong of the test, the trier of fact must determine whether there is substantial similarity in the expression of the ideas of the respective works to constitute infringement.⁷⁹ That is, the court must determine whether the alleged infringer has captured "the total concept and feel" of the creator's work.⁸⁰ This second step is labeled an intrinsic test because it depends on the observations and impressions of the ordinary observer.⁸¹ For this reason, expert testimony and dissection are inappropriate here.⁸²

The *Krofft* court, based upon the *Arnstein* analysis, attempted to bring greater clarity and precision to the law of copyright by developing the foregoing two-part test for substantial similarity.⁸³ However, unlike *Arnstein*, the *Krofft* test fails to establish the necessary distinction between the dual uses of substantial similarity. For this reason, the concept

72. *Sid & Marty Krofft Television Prods., Inc., v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

73. *Id.*

74. *Id.*

75. *Id.* at 1165.

76. *Id.* at 1164.

77. S. Knowles & R. Palmieri, *supra* note 43, at 134.

78. *Sid & Marty Krofft Television Prods., Inc., v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

79. *Id.*

80. *Id.* at 1166-67 (citing *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970)).

81. *Id.*

82. *Id.*

83. NIMMER ON COPYRIGHT, *supra* note 42, § 13.03[E][1], at 13-62.13.

of substantial similarity has been seemingly distorted in the Ninth Circuit's infringement decisions.

In interpreting *Arnstein*, the *Krofft* court acknowledged that to constitute infringement, copying must reach the point of "unlawful appropriation."⁸⁴ In other words, the alleged infringer's copying from the creator's work must extend to protectable expression. As the *Stillman* court articulated: "[C]opyright laws do not protect ideas . . . but only the expressions of ideas. Copying occurs when a defendant usurps the former; unlawful appropriation, however, requires the purloining of expression as well."⁸⁵ The Ninth Circuit chose to analyze this distinction in terms of the elements involved (idea and expression) and the tests employed (extrinsic and intrinsic) to distill the different degrees of similarity.⁸⁶ Accordingly, the primary task in infringement suits has become the determination of whether there has been copying of expression rather than just the underlying ideas.⁸⁷ Nevertheless, the *Krofft* test permits a finding of infringement only if the plaintiff proves both substantial similarity of general ideas under the extrinsic test and substantial similarity of protectable expression of those ideas under the intrinsic test.⁸⁸

American courts have thus adopted the term substantial similarity to define the extent of similarity that a plaintiff must demonstrate in order to prove infringement between the copyrighted work and the defendant's work.⁸⁹ As indicated above, this concept of substantial similarity is applied "to strike a delicate balance between the protection to which authors are entitled under an act of Congress and the freedom that exists for all others to create their works outside the area protected against infringement."⁹⁰

V. THE REASONING OF THE COURTS

A. *The District Court's Reasoning*

In analyzing the defendants' motion for summary judgment on Shaw's claim for copyright infringement, the district court applied the traditional *Krofft* test.⁹¹ Under the extrinsic prong of *Krofft*,⁹² the dis-

84. *Sid & Marty Krofft Television Prods., Inc., v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

85. *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1358 (N.D. Ill. 1989).

86. *Sid & Marty Krofft Television Prods., Inc., v. McDonald's Corp.*, 562 F.2d 1157, 1165 (9th Cir. 1977).

87. *Id.* at 1164.

88. *Id.*

89. NIMMER ON COPYRIGHT, *supra* note 42, § 13.03[A], at 13-15.

90. *Warner Bros. v. American Broadcasting Co.*, 720 F.2d 231, 245 (2d Cir. 1983).

91. *Shaw v. Lindheim*, 908 F.2d 531, 535 (9th Cir. 1990).

trict court examined the similarities in ideas by comparing theme, plot, sequence of events, characters, dialogue, setting, mood and pace of both works.⁹³ The analysis of these characteristics led the court to conclude that reasonable minds might differ as to the substantial similarity between the general ideas of the respective works.⁹⁴ In other words, the district court found that Shaw demonstrated a triable issue regarding substantial similarity of ideas.

Conversely, under the intrinsic prong of the *Krofft* test, the district court concluded that reasonable minds could not differ as to whether the works had a substantially similar "total concept and feel."⁹⁵ Based on Shaw's failure to establish that the defendants had appropriated a substantial amount of protected expression from his script under the intrinsic test, the district court granted summary judgment in favor of the defendants.⁹⁶

B. The Ninth Circuit Court's Reasoning

Like many courts before it, the *Shaw* court commented that substantial similarity as a matter of copyright infringement is an extremely elusive concept.⁹⁷ It is virtually impossible to articulate a definitive standard which adequately measures the similarities between two works which would reveal copying of protected expression.⁹⁸ Nevertheless, the court referred to the bifurcated test developed by the Ninth Circuit in *Krofft*⁹⁹ as the most comprehensive test for determining the issue of substantial similarity.¹⁰⁰ Accordingly, the *Shaw* court used the traditional *Krofft* test as a springboard for creating its own judicial test for substantial similarity.

1. Shaw's Reformulation of the *Krofft* Test

In *Shaw v. Lindheim*,¹⁰¹ the Ninth Circuit examined Shaw's claim for copyright infringement under a modified version of the bifurcated *Krofft* analysis.¹⁰² Under the *Shaw* court's reformulated *Krofft* test, "a

92. See *supra* notes 73-77 and accompanying text.

93. *Shaw v. Lindheim*, 908 F.2d 531, 535-36 (9th Cir. 1990).

94. *Id.* at 536.

95. *Id.* at 535.

96. *Id.* at 536.

97. *Id.* at 534.

98. *Shaw v. Lindheim*, 908 F.2d 531, 534 (9th Cir. 1990).

99. 562 F.2d 1157 (9th Cir. 1977).

100. *Shaw v. Lindheim*, 908 F.2d 531, 534 (9th Cir. 1990).

101. *Id.* at 531.

102. *Id.* at 539-41.

showing of substantial similarity with reference to the eight objective components of expression in the extrinsic test applied to literary works creates a genuine issue for trial.”¹⁰³ Consequently, if a court’s analysis under the extrinsic test alone indicates that reasonable minds could conclude that there is substantial similarity between the protectable expression of both works, there exists a triable issue which precludes summary judgment against the plaintiff.¹⁰⁴ Although the analysis of the *Shaw* court appears sound, its reformulated version of the *Krofft* test is nonetheless problematic.

2. Rationale Underlying the *Shaw* Test

The Ninth Circuit’s decision in *Shaw* was based primarily on its perception that the traditional *Krofft* bifurcated analysis, based on the extrinsic/intrinsic distinction between ideas and expression, has changed drastically.¹⁰⁵ In this court’s view, the traditional two-prong *Krofft* test has evolved into “objective and subjective analyses of *expression*.”¹⁰⁶ This evolution has apparently expanded the modern extrinsic test to encompass all objective elements of expression.¹⁰⁷ Specifically, the *Shaw* court noted that prior panels have looked to the “concrete elements of the works” to assist in this extrinsic comparison.¹⁰⁸ These concrete elements include: plot, character, theme, dialogue, mood, setting, pace and sequence of events.¹⁰⁹ By looking to such objective elements of the disputed works, this prong effectively compares substantial similarity of expression rather than similarity of mere ideas.¹¹⁰

This evolution of the extrinsic test has purportedly left the intrinsic test a mere subjective assessment of similarities in expression.¹¹¹ Hence, the court deemed the intrinsic test “virtually devoid of analysis” and therefore impractical for the purposes of summary judgment motions.¹¹² Summary judgment motions should not be decided on “a purely subjective determination of similarity” as would occur under the current intrinsic test.¹¹³ The court reasoned that engaging in subjective analyses in deciding infringement as a matter of law is inappropriate: “the judge’s

103. *Id.* at 539.

104. *Id.* at 535.

105. *Shaw v. Lindheim*, 908 F.2d 531, 535 (9th Cir. 1990).

106. *Id.*

107. *Id.*

108. *Id.* at 534 (citing *Narell v. Freeman*, 872 F.2d 907, 912 (9th Cir. 1989)).

109. *Shaw v. Lindheim*, 908 F.2d 531, 534 (9th Cir. 1990).

110. *Id.* at 535.

111. *Id.*

112. *Id.*

113. *Id.* at 537.

function is not [herself] to weigh the evidence and determine the truth of the matter but to determine whether there is a genuine issue for trial."¹¹⁴ Therefore, the *Shaw* court determined that these changes in the *Krofft* two-part test necessitated a new standard for determining whether a plaintiff has created a triable issue of substantial similarity.¹¹⁵

According to *Shaw*, the appropriateness of summary judgment depends upon "whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law."¹¹⁶ Further, the court announced that:

Although summary judgment is not highly favored on questions of substantial similarity in copyright cases, summary judgment is appropriate if the court can conclude, after viewing the evidence and drawing inferences in a manner most favorable to the non-moving party, that no reasonable juror could find substantial similarity of ideas *and expression*.¹¹⁷

Consequently, the court held that "a showing of substantial similarity with reference to the eight objective components of expression in the extrinsic test . . . creates a genuine issue for trial."¹¹⁸ The court reasoned that since individuals differ in reasoning and emotional reaction, a subjective comparison of literary works "that are objectively similar in their expression of ideas must be left to the trier of fact."¹¹⁹ As a result, the *Shaw* court found it improper to hold that no substantial similarity exists between the works, as a matter of law, where the author has satisfied the extrinsic, but not the intrinsic, test.¹²⁰

The *Shaw* court further attempted to justify this new test by distinguishing, from the instant case, contrary opinions which affirmed grants of summary judgment for defendant on the issue of substantial similarity. The Ninth Circuit acknowledged that it had been appropriate in *Aliotti v. R. Dakin & Co.*¹²¹ ("Aliotti") and *Data East USA, Inc. v. Epyx, Inc.*,¹²² ("Data East") for the court to engage in a subjective assessment of substantial similarity in ruling on a motion for summary judgment.¹²³ How-

114. *Shaw v. Lindheim*, 908 F.2d 531, 537 (9th Cir. 1990) (quoting *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986) (bracketed material original)).

115. *Id.* at 539.

116. *Id.* at 537 (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 251-52 (1986)).

117. *Shaw v. Lindheim*, 908 F.2d 531, 533 (9th Cir. 1990) (quoting *Narell v. Freeman*, 872 F.2d 907, 909-10 (9th Cir. 1989) (emphasis added)).

118. *Shaw v. Lindheim*, 908 F.2d 531, 539 (9th Cir. 1990).

119. *Id.*

120. *Id.* at 537.

121. 831 F.2d 898 (9th Cir. 1987).

122. 862 F.2d 204 (9th Cir. 1988).

123. *Shaw v. Lindheim*, 908 F.2d 531, 537 (9th Cir. 1990).

ever, the holdings in both *Aliotti* and *Data East* were based on a limiting principle not found in the instant case. This limiting principle was described as follows: "no substantial similarity of expression will be found when 'the idea and its expression are . . . inseparable,' given that 'protecting the expression in such instances could confer a monopoly of the *idea* upon the copyright owner.'" ¹²⁴

In *Aliotti*, the owner of the copyright in the "Ding-A-Saurs" line of toy dinosaurs brought an infringement suit against the manufacturers of a similar line of toy dinosaurs known as "prehistoric pets."¹²⁵ In reviewing the infringement claim, the court stated that similarity of expression could not be established by the mere fact that both dinosaurs are "gentle and cuddly" given that most stuffed toys are designed this way.¹²⁶ Accordingly, the court held that "[n]o copyright protection may be afforded to the idea of producing stuffed dinosaur toys or to elements of expression that necessarily follow from the idea of such dolls."¹²⁷

Similarly, in *Data East*, the plaintiffs alleged that the *World Karate Championship* home video game developed and distributed by defendant infringed their copyright in the *Karate Champ* home video game.¹²⁸ After analyzing the features of both games, the court found that the visual depiction of karate matches which necessarily follows from the idea of karate combat is thus inseparable from the sport of karate.¹²⁹ As such, the expression inherent in the plaintiff's video game is not protectable.¹³⁰ Based on these cases, the *Shaw* court emphasized that the subjective analysis of substantial similarity as a matter of law is appropriate in a limited context; where there is unity of an idea and the expression of that idea.¹³¹

Additionally, the court announced that the Ninth Circuit has implicitly recognized the distinction between contexts where idea and expression merge in works and those where the idea is distinct from the written expression of that idea.¹³² Given the variety of possible expressions of an idea together with the objective criteria available under the extrinsic test, the court concluded that the intrinsic test cannot remain

124. *Id.* at 538 (citing *Data East USA, Inc. v. Epyx, Inc.*, 862 F.2d at 208 (quoting *Aliotti v. R. Dakin & Co.*, 831 F.2d at 901.)).

125. *Aliotti v. R. Dakin & Co.*, 831 F.2d 898 (9th Cir. 1987).

126. *Id.* at 901.

127. *Id.* (citing *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971) (finding the idea and expression of jeweled bee pins to be inseparable)).

128. *Data East USA, Inc. v. Epyx, Inc.*, 862 F.2d 204, 205-06 (9th Cir. 1988).

129. *Id.* at 209.

130. *Id.*

131. *Shaw v. Lindheim*, 908 F.2d 531, 538 (9th Cir. 1990).

132. *Id.*

the sole basis for granting summary judgment.¹³³

C. Application of the Reformulated *Krofft* Test

In *Shaw*, the Ninth Circuit reiterated that to establish a successful copyright infringement claim, the plaintiff must demonstrate that he or she owns a valid copyright and that the defendant copied protectable elements of the work.¹³⁴ Because direct evidence of copying is rarely available, a plaintiff may establish copying by showing that the infringer had access to the work and that the two works are substantially similar.¹³⁵ As the defendants in *Shaw* conceded the issues of Shaw's valid copyright and their access to Shaw's work, the only issue was that of substantial similarity as an element of copying.

Nevertheless, before reviewing the district court's findings under the reformulated *Krofft* test, the court examined the effect of the defendants' access to Shaw's work and the effect of identical titles on the issue of substantial similarity.¹³⁶ Although access was not at issue since defendants conceded access to Shaw's script, the court nonetheless focused on access in relation to the plaintiff's burden of proof for substantial similarity.¹³⁷ Pursuant to the "Inverse Ratio Rule" enunciated in *Krofft*, proof of a high degree of access justifies a lower standard of proof needed to demonstrate substantial similarity concerning the element of copying.¹³⁸

133. *Id.*

134. *Id.* at 533-34.

135. *Id.* at 534 (citing *Narell v. Freeman*, 872 F.2d 907, 910 (9th Cir. 1989)).

136. *Shaw v. Lindheim*, 908 F.2d 531, 539-40 (9th Cir. 1990). A third factor not mentioned but likely considered by the *Shaw* court was the nature of the defendant's conduct in appropriating the plaintiff's copyrighted work. In particular, when the defendant's method of appropriating a copyrighted work offends a court, such conduct can often influence the court's decision. See *Recent Developments*, *supra* note 40, at 1284. For instance, in *Runge v. Lee*, after publishing a book concerning newly developed facial exercise techniques the plaintiff hired the defendant and taught her these new exercises. *Runge*, 441 F.2d 579, 580 (9th Cir.), *cert. denied*, 404 U.S. 887 (1971). When the defendant left the plaintiff's employ, she published her own book describing the facial techniques contained in the plaintiff's copyrighted book. *Id.* Consequently, the Ninth Circuit found that the defendant's actions constituted copyright infringement. *Id.*

It is likewise plausible that the *Shaw* court's holding in favor of the plaintiff was based on this very premise. Defendant Lindheim's method of appropriating Shaw's script likely offended the Ninth Circuit's sense of justice. Specifically, to be considered for production as a television series, Shaw was required to submit his script to Lindheim, as the head of the Dramatic Programming Department at NBC. Accordingly, Lindheim took unfair advantage of this position of authority by appropriating Shaw's script at that time.

137. *Shaw v. Lindheim*, 908 F.2d 531, 539 (9th Cir. 1990).

138. *Id.* (citing *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1172 (9th Cir. 1977)): "[W]here clear and convincing evidence of access is presented, the quantum of proof required to show substantial similarity may . . . be lower than when access is shown merely by a preponderance of the evidence." *Id.*

This Inverse Ratio Rule provides that the greater the evidence of "access" the lesser degree of substantial similarity is needed to establish copying.¹³⁹ Hence, the court found the defendants' admission of access to Shaw's script to be a factor in Shaw's favor.¹⁴⁰

The court further indicated the fact that the two works were entitled *The Equalizer* weighed in Shaw's favor: "[i]f the copying of a title is not an act of copyright infringement, it may . . . have copyright significance as one factor in establishing whether the substance of plaintiff's work has been copied."¹⁴¹

Finally, the court applied the extrinsic test to the disputed scripts to determine whether Shaw had demonstrated a genuine issue for trial. Applying the objective criteria in its extrinsic comparison of the works, the court found the plaintiff's script and the defendants' *The Equalizer* series to be substantially similar in theme, plot, sequence of events and dialogue.¹⁴²

In examining the similarities in theme, the court noted that both plaintiff's and defendants' *The Equalizer* storylines focused on the *Equalizer* character.¹⁴³ Both scripts revolve around the *Equalizer*, a lone man working outside the traditional law enforcement system.¹⁴⁴ However, the similarities in theme extend beyond the lead character: "[T]he *Equalizer* in each script solicits clients requiring assistance that conventional law enforcement cannot offer . . . each lead character describes his role as to 'equalize' or 'shake up' the odds."¹⁴⁵

Turning to similarities in plot and sequence of events, the *Shaw* court found many of the events in both works to be substantially similar.¹⁴⁶ For instance: (1) both works involved a criminal organization that blackmails a candidate for public office; and (2) both organizations attempt to kill, by means of an oncoming truck, a prospective equalizer client, who had discovered the organization.¹⁴⁷ The court emphasized that although these events may not appear unique by themselves, "the fact that both scripts contain all of these similar events should give rise to

139. *Shaw v. Lindheim*, 908 F.2d 531, 539 (9th Cir. 1990).

140. *Id.*

141. *Id.* at 540 (quoting 1 M. NIMMER, NIMMER ON COPYRIGHT, § 2.16, at 2-188 (1989)).

142. *Shaw v. Lindheim*, 908 F.2d 531, 540 (9th Cir. 1990). However, the court also found that similarities in setting, mood and pace of both works were attributable to any action adventure and thus constituted unprotectable expression. For this reason, these objective elements could not be considered in the court's determination of substantial similarity. *Id.* at 541.

143. *Id.* at 540.

144. *Id.*

145. *Id.*

146. *Id.* at 540-41.

147. *Shaw v. Lindheim*, 908 F.2d 531, 541 (9th Cir. 1990).

a triable question of substantial similarity.”¹⁴⁸

Finally, the court found striking similarities in the dialogue and characters in both works: “Both leads are well dressed, wealthy and have expensive tastes. The most striking similarity is their self-assuredness and unshakable faith in the satisfactory outcome of any difficult situation.”¹⁴⁹ Although the demeanor of the *Equalizer* may be identical to that of other action adventure characters such as James Bond, the court noted that the totality of the similarities between Shaw’s lead character, Jericho, and Lindheim’s lead character, McCall, goes beyond any elements inherent in *The Equalizer* theme.¹⁵⁰ Based on the foregoing, the court found a sufficient showing of substantial similarity under the extrinsic test to constitute a triable issue as to substantial similarity.¹⁵¹ Consequently, the district court’s grant of summary judgment was reversed and Shaw’s claim for copyright infringement was remanded for a trial on the merits.¹⁵²

VI. ANALYSIS

A successful claim for copyright infringement necessarily embodies two types of substantial similarity: substantial similarity relating to proof of “permissible” copying and substantial similarity relating to “infringing” copying, also referred to as unlawful appropriation.¹⁵³ As one court has declared, “substantial similarity is not always substantial similarity.”¹⁵⁴ Therefore, any test developed for determining copyright infringement must clearly distinguish between these dual forms of substantial similarity.¹⁵⁵

A. Failure of the Shaw Test to Distinguish the Dual Types of Substantial Similarity

One of the primary defects in the *Shaw* test is its distortion of the definition of substantial similarity for purposes of copyright infringe-

148. *Id.*

149. *Id.*

150. *Id.*

151. *Id.*

152. *Shaw v. Lindheim*, 908 F.2d 531, 541-42 (9th Cir. 1990).

153. *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946); *See also* *Universal Athletic Sales Co. v. Salkend*, 511 F.2d 904, 907 (3d Cir.), *cert denied*, 423 U.S. 863 (1975).

154. *Universal Athletic Sales Co. v. Salkend*, 511 F.2d 904, 907 (3d Cir.), *cert. denied*, 423 U.S. 863 (1975).

155. *See* *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1358-59 (N.D. Ill. 1989) (stressing the importance of distinguishing between these dual forms of substantial similarity in reviewing defendant’s claim for copyright infringement).

ment.¹⁵⁶ Specifically, the reliance on an extrinsic test alone fails to sufficiently distill the dual usages of substantial similarity inherent in modern copyright law.¹⁵⁷ As the *Stillman*¹⁵⁸ court accurately reflected, the difficulties in adjudicating copyright infringement actions stem from the dual usages of substantial similarity: "Substantial similarity can refer to the likeness between two works sufficient to give rise to an inference . . . that the defendant . . . [copied] the plaintiff's work. Substantial similarity, however, is also used as a term of art relating to the unlawful nature of the similarities between the works."¹⁵⁹

This confusion is initially evident in the *Shaw* court's characterization of the essential elements of a copyright infringement action. As enunciated by the court: "To establish a successful copyright infringement claim, Shaw must show that he owns the copyright and that defendant copied protected elements of the work."¹⁶⁰ Further, copying may be established by circumstantial evidence demonstrating that the "infringer" had access to the work and that the two works are *substantially similar*.¹⁶¹

Applying the so called Inverse Ratio Rule, the court stated that the defendant's "degree of access justifies a lower standard of proof to show substantial similarity."¹⁶² In looking at this Inverse Ratio Rule, the late Professor Nimmer explained: "[S]ince a very high degree of similarity is required in order to dispense with proof of access, it must logically follow that *where proof of access is offered, the required degree of similarity may be somewhat less* than would be necessary in the absence of such proof."¹⁶³

Reliance on the Inverse Ratio Rule, together with this court's characterization of the elements of infringement, seriously confuses the dual forms of substantial similarity: (1) substantial similarity as an element of copying and (2) substantial similarity of protectable expression as proof of unlawful appropriation.¹⁶⁴ The Inverse Ratio Rule is only relevant to

156. *Shaw v. Lindheim*, 908 F.2d 531, 534 (9th Cir. 1990).

157. *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1358-59 (N.D. Ill. 1989).

158. 720 F. Supp. 1353 (N.D. Ill. 1989).

159. *Id.* at 1358. This second form of substantial similarity is otherwise referred to as unlawful appropriation.

160. *Shaw v. Lindheim*, 908 F.2d 531, 533-34 (9th Cir. 1990) (citing *Narell v. Freeman*, 872 F.2d at 910).

161. *Id.* at 534.

162. *Id.* at 539.

163. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1172 (9th Cir. 1977) (quoting 2 M. NIMMER, NIMMER ON COPYRIGHT, § 143.4 at 634 (1976)).

164. *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1358 (N.D. Ill. 1989); *Universal Athletic Sales Co. v. Salkend*, 511 F.2d 904, 909-10 (3d Cir. 1975).

proof of substantial similarity as an element of copying.¹⁶⁵ Conversely, this rule is not properly applied to reduce plaintiff's burden of proof concerning similarities in protectable expression. Rather, the plaintiff must provide independent proof of similarities in expression to constitute infringement.

While the *Shaw* court's depiction of the evolution of the *Krofft* test was accurate, its new test fails to provide a workable framework for adjudicating infringement suits. Accordingly, although the court recognized that a finding of infringement must be based on substantial similarity in protectable forms of expression,¹⁶⁶ its rule may nonetheless lead to inconsistent results. In particular, the employment of the "Inverse Ratio Rule" may lead to future findings of infringement based on only a minimal degree of similarity between unprotectable elements in the works.

B. Failure to Comport with Copyright Principles

The aforementioned flaws inherent in the *Shaw* test are nevertheless not surprising given the shortcomings of the *Krofft* approach itself. Primarily, the *Krofft* bifurcated analysis for substantial similarity fails to provide the needed balance between the competing interests in copyright law. These interests include the desire to encourage individual ingenuity in the arts, on one hand, and the desire to promote national progress by allowing individuals to use the fruits of another's creativity, on the other.¹⁶⁷ While the *Krofft* court recognized that copyright protection extends only to expression, it nonetheless held that to constitute infringement, there must be "substantial similarity of not only the general ideas but of the expressions of those ideas as well."¹⁶⁸ There is absolutely no support in copyright law for this notion of idea and expression similarity as a prerequisite for finding infringement.

It must be remembered that a primary purpose of copyright law is to create the most efficient and productive balance between protection, that is, the economic incentive to produce creative works, and dissemination of information to promote learning and cultural development.¹⁶⁹ By eliminating the idea-expression distinction, the *Shaw* test not only fails to strike the necessary balance between these interests but also, repudiates a

165. See NIMMER ON COPYRIGHT, *supra* note 42, § 13.03[D], at 13-62.1-62.2.

166. *Shaw v. Lindheim*, 908 F.2d 531, 533 (9th Cir. 1990).

167. *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1357 (N.D. Ill. 1989).

168. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

169. See UNITED STATES CONST. art. I, § 8, cl. 8 (granting Congress the power "[t]o promote the Progress of Science and Useful Arts, by securing for Limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.").

general principle of copyright law: that copyright protection extends only to an author's expression and not to the underlying ideas or concepts.¹⁷⁰ To grant protection to mere ideas would permit withdrawal of general ideas from the stock of materials which would otherwise be available to authors.¹⁷¹ Accordingly, such protection would hinder rather than promote a primary purpose of copyright law.

C. *Prejudicial Ramifications of the Shaw Test.*

In support of its revised *Krofft* test, the Ninth Circuit skillfully distinguished earlier precedent which granted summary judgment in favor of the defendant.¹⁷² However, the court failed to recognize the prejudicial effect that the reformulated test would have on future defense motions for summary judgment. Authorities have noted that *Krofft* represents one of the most extreme tests for substantial similarity. The *Krofft* two-part test may result in a finding of infringement based on non-literal taking of expression which borders on the taking of mere ideas.¹⁷³

The approach adopted in *Shaw* further reduces the plaintiff's burden in opposing a defense motion for summary judgment by only requiring satisfaction of the extrinsic test, a test traditionally employed for comparing similarities in ideas. Accordingly, *Shaw* limits, and virtually eliminates, a court's ability to rule for a defendant before trial "because ideas underlying the works in most cases are similar in some respect . . . [otherwise] plaintiff never would have filed suit."¹⁷⁴

Although the *Shaw* approach may serve as a deterrent to potential infringers, it could also deter wrongly accused defendants from creating original works in the future. The *Krofft* court itself acknowledged the need for a limiting principle to reconcile the divergent goals inherent in copyright law: "[P]rotection must be closely monitored to permit the author to experience the necessary encouragement to create while allowing society use of the conceptual subject matter upon which the crea-

170. See, e.g., *Warner Bros. v. American Broadcasting Co.*, 654 F.2d 204, 208 (2d Cir. 1981): "It is axiomatic that copyright protection only extends to the expression of the author's ideas, not the idea itself."

171. *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1357 (N.D. Ill. 1989).

172. *Shaw v. Lindheim*, 908 F.2d 531, 538 (9th Cir. 1990). "By creating a discrete set of standards for determining the objective similarity of literary works, the law of this circuit has implicitly recognized the distinction between situations in which idea and expression merge [as in *Aliotti* and *Data East*] . . . and those in which the idea is distinct from the written expression of a concept [as in the instant case. . . ." *Id.*

173. See E. Samuels, *supra* note 51, at 353.

174. See *Recent Developments*, *supra* note 40, at 1294.

tion is based."¹⁷⁵

While summary judgment is traditionally not favored on questions of substantial similarity in copyright cases, non-infringement may be determined as a matter of law "either because the similarity between two works concerns only 'non-copyrightable elements of plaintiff's work,' . . . or because no reasonable jury, properly instructed, could find that the two works are substantially similar. . . ."¹⁷⁶ While the *Shaw* court properly denied the defendants' motion for summary judgment on the issue of substantial similarity, it nevertheless could have employed an alternative approach that would provide a sounder analytical basis for deciding future infringement claims.

D. Alternative Approach

In *Shaw*, the Ninth Circuit could have adopted an alternative approach for determining copyright infringement which is virtually identical to that currently adhered to by the Second, Third and Seventh Circuit courts. The superiority of this approach lies in its clarity in defining the necessary elements of a successful infringement action. Because this alternative approach is premised upon the traditional *Arnstein* approach, it provides a more viable framework for analyzing the dual forms of substantial similarity underlying copyright infringement suits. Thus, the adoption of the approach set forth below would eliminate the confusion and inconsistency surrounding the substantial similarity analysis which has plagued the Ninth Circuit for years.

1. Essential Elements of Copyright Infringement

To establish a successful claim for copyright infringement, the alternative approach, like *Arnstein*, requires a plaintiff to demonstrate the following: (1) ownership of a valid copyright; (2) permissible copying; and (3) unlawful appropriation.¹⁷⁷ To establish permissible copying by the defendant, a plaintiff must show: (a) access, or a reasonable opportunity

175. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1163 (9th Cir. 1977).

176. *Warner Bros. v. American Broadcasting Co.*, 720 F.2d 231, 240 (2d Cir. 1981) (citing *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905, 918 (2d Cir. 1980)).

177. *See Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946) (emphasizing the need to distinguish between "permissible" copying and "illicit infringing" copying.) *See also Universal Athletic Sales Co. v. Salkend*, 511 F.2d 904, 907 (3d Cir.), *cert. denied*, 423 U.S. 863 (1975) (effectively restoring the bifurcated analysis originally developed in *Arnstein*. In *Universal Athletic*, the court held that to establish copyright infringement, a plaintiff must prove: (1) copying and (2) substantial similarity between the works. *Universal Athletic*, 511 F.2d at 907. In other words, "plaintiff must demonstrate that the copying went so far as to constitute infringement." *Universal Athletic*, 511 F.2d at 907.).

to view, and (b) "marked" similarity¹⁷⁸ between the works "when compared in their entirety, including both protectable and unprotectable material."¹⁷⁹ Proof of permissible copying here calls for "marked," as opposed to "substantial" similarity, to avoid confusing the degree of similarity needed to establish "copying" with that required to prove "unlawful appropriation."¹⁸⁰

The only exception to the plaintiff's burden of proof on the issue of permissible copying arises where similarities between the works are so striking as to preclude the possibility that the defendant independently created his or her work.¹⁸¹ In this sense, the creator/plaintiff does not have to establish the infringer's access to the copyrighted work because such copying cannot be explained by coincidence or independent creation.¹⁸²

Once "permissible" copying has been established, the plaintiff must prove that this copying was sufficiently substantial to constitute unlawful appropriation.¹⁸³ In other words, in determining whether the defendant's copying went so far as to reveal an infringement, the court shall determine whether the similarities extend to something more than mere generalized ideas or concepts.¹⁸⁴ The extent of similarity which will constitute a substantial and hence infringing similarity, however, presents one of the most difficult questions in copyright law.¹⁸⁵

Under the alternative approach, the issue of unlawful appropriation shall be determined by the audience/ordinary observer test.¹⁸⁶ The threshold inquiry here is "whether the accused work is so similar to the plaintiff's work that an . . . [ordinary observer] would conclude that the defendant unlawfully appropriated the plaintiff's protectible expression by taking material of substance and value."¹⁸⁷ This traditional audience/ordinary observer test will be supplemented by the use of analytic dissec-

178. Professor Lionel Sobel, Mar. 12, 1990 copyright law lecture.

179. *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1358 (N.D. Ill. 1989) (quoting 3 M. NIMMER, NIMMER ON COPYRIGHT, § 13.03[E], at 13-55 (1988)).

180. See Note, *supra* note 70, at 557-58 [supporting this distinction because "otherwise, the copying determination would suffice to decide both issues."]. Note also: This approach does not adhere to the Inverse Ratio Rule for the reasons set forth earlier.

181. NIMMER ON COPYRIGHT, *supra* note 42, § 13.03[B], at 13-17.

182. *Id.*

183. *Arnstein v. Porter*, 154 F.2d 464, 472-73 (2d Cir. 1946).

184. *Warner Bros. v. American Broadcasting Co.*, 654 F.2d 204, 208 (2d Cir. 1981).

185. NIMMER ON COPYRIGHT, *supra* note 42, § 13.03[A], at 13-16.

186. See *Arnstein*, 154 F.2d at 472; *Nash v. Columbia Broadcasting Sys.*, 704 F. Supp. 823, 826 (N.D. Ill. 1989).

187. *Nash v. Columbia Broadcasting Sys.*, 704 F. Supp. 823, 826 (N.D. Ill. 1989) (quoting *Atari v. North American*, 672 F.2d 607, 614 (7th Cir.), *cert. denied*, 459 U.S. 880 (1982)).

tion. By employing dissection as an initial step, this approach will better distinguish unprotectable forms of expression and general ideas from protectable forms of expression. Dissection will ensure that the determination of "unlawful appropriation" is based solely on "protectable" forms of expression.¹⁸⁸ Consequently, the alternative approach will effectuate the primary purposes of copyright law and remain consistent with current case law, as demonstrated below, by using this revised version of the audience/ordinary observer test.

2. Fulfillment of Copyright Law Objectives

The audience/ordinary observer test employed under the alternative approach comports with the principles of copyright law because it recognizes that the audience provides the author or artist with the economic incentive to create.¹⁸⁹ One of copyright's primary purposes is to encourage creativity and dissemination of creative works so that the public may benefit from the labor of authors:

The Act accomplishes this goal by giving authors a legally protected interest in the potential rewards resulting from public approval of their work. If the public perceives the two works as distinct, then the public gains from having both works. Similarly, if ordinary members of the public cannot recognize the similarity between an original and allegedly infringing work, the infringing work probably has not damaged the original work's value in the market place.¹⁹⁰

On the other hand, if the infringer's work could serve as a substitute for the creator's work, the audience or ordinary observer would buy the infringer's work instead. In other words, the infringer could eliminate the market for the creator's work. Hence, the audience test leads to a finding of infringement only when the creator's audience, the source of his economic incentive, would deem the infringer's work substantially

188. In examining the second step of the *Arnstein* test, Professor Nimmer indicated that it does not seem reasonable to expect the ordinary observer to determine the issue of unlawful appropriation without dissection at least to delineate that portion of the plaintiff's work which is protectable. It may be that the *Arnstein* opinion was not intended to preclude dissection on the second question for that limited purpose. NIMMER ON COPYRIGHT, *supra* note 42, § 13.03[E][1], at 13-62.9 n.264.

189. Note, *Copyright Infringement Actions: The Proper Role for Audience Reactions in Determining Substantial Similarity*, 54 S. CAL. L. REV. 385, 393 (1981); See also *Arnstein*, 154 F.2d at 472 ("The plaintiff's legally protected interest is not, as such, his reputation as a musician but his interest in the potential financial returns from his compositions which derive from the lay public's approbation of his efforts.") *Id.*

190. See *Recent Developments*, *supra* note 40, at 1291.

similar.¹⁹¹

3. Application of Alternative Approach to *Shaw*

Applying the alternative approach to *Shaw* provides a viable analytic framework for copyright infringement which would yield the same favorable results for the plaintiff, Shaw. As indicated earlier, the defendants in *Shaw* conceded that Shaw had a valid copyright and that defendant Lindheim had access to Shaw's script.¹⁹² Thus, the only issue under the element of permissible copying is marked similarity.

Comparing the two scripts in their entirety demonstrates a marked similarity between them. Both scripts are fast-paced, set in a metropolitan backdrop with "ominous and cynical moods that are lightened by the Equalizer's victory."¹⁹³ Although these similarities constitute unprotectable forms of expression common to any action-adventure, they are nonetheless applicable under the marked similarity determination.¹⁹⁴ Further, both works can be characterized as a modern day "Sir Galahad" adventure. In both the script and the series, the Equalizer is a lone man working outside the traditional law enforcement system trying to equalize the odds for less fortunate individuals.¹⁹⁵ Finally, the works have identical titles.¹⁹⁶ The fact that the defendants appropriated Shaw's title for their series provides further evidence that the series was intended to closely resemble Shaw's work.¹⁹⁷

Next, the determination of unlawful appropriation focuses on whether the defendants appropriated a sufficient portion of plaintiff's protectable expression to constitute unlawful appropriation.¹⁹⁸ Before employing the audience ordinary observer test here, it is necessary to "dissect" the works and thereby separate the protectable from the unprotectable forms of expression. This dissection can be achieved by dividing the works into their objective characteristics of mood, setting, pace, theme, sequence of events, plot, dialogue and characters.¹⁹⁹

191. *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946).

192. *Shaw v. Lindheim*, 908 F.2d 531, 534 (9th Cir. 1990).

193. *Id.* at 541.

194. See Note, *supra* note 70, at 558 (The first step in the *Arnstein* analysis requires the "factfinder to compare the disputed works without regard to whether the similarities rest on protectable or unprotectable material.").

195. *Shaw v. Lindeim*, 908 F.2d 531, 540 (9th Cir. 1990).

196. *Id.* at 533.

197. *Id.* at 539-40.

198. *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946).

199. See Note, *All Puff and No Stuff: Avoiding the Idea/Expression Dichotomy*, 9 LOY. L.A. ENT. L.J. 337, 346 n.83 ("Dissection involves analysis and comparison of the works by breaking them down and comparing the elements.").

In *Shaw*, the extrinsic analysis demonstrated that similarities in the mood, setting and pace of both works could not constitute infringement since these similarities stem from unprotectable scènes à faire.²⁰⁰ On the other hand, an analysis of theme, sequence of events, characters and dialogue reflect similarities in protectable forms of expression.²⁰¹

The themes of the works are substantially similar in that they revolve around the lead character, the Equalizer. The Equalizer is a lone man working outside the traditional law enforcement system to equalize the odds for the common people.²⁰² This similarity in the theme of both works extends to elements of protectable expression.

As to sequence of events, many of the events in the two works are substantially similar. For instance, "[i]n both scripts, henchmen for the criminal organization interrupt the Equalizer's initial meeting with the client, . . . and are foiled as the Equalizer saves the client."²⁰³ Although the events that appear in both works may not seem extraordinarily unique, the fact that both scripts contain numerous similarities should give rise to a triable question of substantial similarity.

Finally, similarities between the characters of the two works extend to protectable expression. The Equalizer describes his job as "the greatest thing a man could do with his life . . . [that is] help give somebody an even shot, shake up the odds a little."²⁰⁴ As the district court emphasized, the most striking similarity between McCall, the defendants' lead character, and Jericho, Shaw's lead character, "is their self-assuredness and unshakable faith in the satisfactory outcome of any difficult situation."²⁰⁵ Moreover, the lead characters are similar in that both are educated, well dressed, wealthy and have expensive tastes.²⁰⁶

The foregoing similarities lead to a finding under the audience ordinary observer test that the defendants have unlawfully appropriated a substantial amount of Shaw's protectable expression. Due to the nationwide televising of *The Equalizer* produced by the defendants, Shaw no longer has a viable story to sell. Any broadcasting station which had previously contemplated producing Shaw's script would no longer be willing to do so; Shaw's potential audience has been appropriated by the defendants' *The Equalizer* series. As authorities have asserted: "If so much is taken that the value of the original is sensibly diminished, or the

200. *Shaw v. Lindheim*, 908 F.2d 531, 541 (9th Cir. 1990).

201. *See Shaw v. Lindheim*, 908 F.2d 531, 540-41 (9th Cir. 1990).

202. *Id.* at 540.

203. *Id.* at 541.

204. *Id.* at 535.

205. *Id.* at 536.

206. *Shaw v. Lindheim*, 908 F.2d 531, 536 (9th Cir. 1990).

labors of the original author are substantially to an injurious extent appropriated by another, that is sufficient . . . to constitute a piracy"²⁰⁷ Under the audience ordinary observer test, a reasonable jury could conclude that the words are substantially similar as to the protectable elements of expression. Therefore, Shaw has presented a triable issue concerning the elements of "permissible copying" and "unlawful appropriation" under the alternative approach, an issue not examined by the *Shaw* test.

4. Parallel Approaches Applied by the Circuit Courts

An examination of current case law further demonstrates that the suggested alternative approach is a workable standard for copyright infringement suits. Recently, many circuit courts have applied modified versions of the *Arnstein* approach in determining copyright infringement claims as a matter of law.²⁰⁸

a. Second Circuit Approach: *Walker v. Time Life Films, Inc.*²⁰⁹

In *Walker v. Time Life Films, Inc.*²¹⁰ the Second Circuit upheld the grant of summary judgment for the defendant since "no reasonable observer could find substantial similarity between the protectable elements of [the] plaintiff's book, ['Fort Apache'] and defendants' movie ['Fort Apache: The Bronx']."²¹¹ This infringement suit initially arose out of those two works which both depicted the violence and urban decay of the forty-first precinct of the New York City Police Department.²¹² Walker contended that defendants copied their screenplay from the manuscript for his book.²¹³ This copying apparently occurred after the manuscript disappeared from the forty-first precinct station house shortly after Walker discussed the book with defendant Gould.²¹⁴

In reaching its conclusion, the court employed a bifurcated analysis for the infringement determination premised upon the *Arnstein* approach. Under the first step of the analysis, evidence of access and sub-

207. NIMMER ON COPYRIGHT, *supra* note 42, § 13.03[A], at 13-45 (citing *Folsom v. Marsh*, 9 Fed. Cas. 348, no. 4901 (C.C. Mass. 1841)).

208. *See, e.g.*, *Warner Bros. v. American Broadcasting Co.*, 654 F.2d 204 (2d Cir. 1981); *Walker v. Time Life Films, Inc.*, 784 F.2d 44 (2d Cir. 1986); *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353 (N.D. Ill. 1989); *Midway Mfg. Co. v. Bandai-America, Inc.*, 546 F. Supp. 125 (D.N.J. 1982).

209. 784 F.2d 44 (2d Cir. 1986).

210. *Id.*

211. *Id.* at 46.

212. *Id.*

213. *Id.* at 47.

214. *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 47 (2d Cir. 1986).

stantial similarity were used to determine the issue of copying alone.²¹⁵ Under the second step of the analysis, the plaintiff was required to demonstrate that the defendant copied "protectible expression" to establish unlawful appropriation.²¹⁶ The court characterized its review under this latter step as follows: "To determine whether the grant of summary judgment was proper, we must decide whether the lack of substantial similarity between the protectible aspects of the works was 'so clear as to fall outside the range of disputed fact questions' requiring resolution at trial."²¹⁷

In finding that the similarities between the works did not constitute infringement, the *Walker* court initially noted that Walker's book was an account of factual events.²¹⁸ According to the court, "[t]his renders proof of infringement more difficult, because copyright protection . . . does not extend to facts or to true events . . ."²¹⁹ Examining the works with more specificity, the court emphasized that the primary similarities between the works constituted unprotectable forms of expression.²²⁰ For instance, the appearance of drunks, prostitutes and other city-dwelling derelicts "would appear in any realistic work about the work of policemen in the South Bronx."²²¹ Because these elements necessarily result from the choice of a setting or situation they constitute unprotectable scènes à faire.²²² Likewise, "foot chases and the morale problems of policemen" which appear in both works are recurring themes prevalent in most police fiction.²²³ These elements are likely to appear in any realistic story concerning the everyday drama of a police officer's work, particularly one set in the South Bronx.²²⁴ Consequently, the Second Circuit concluded that the foregoing similarities do not demonstrate a material issue concerning substantial similarity as a matter of infringement.²²⁵

215. *Id.* at 48.

216. *Id.* at 50.

217. *Id.* at 48 (quoting *Warner Bros. v. American Broadcasting Co.*, 720 F.2d 231, 239 (2d Cir. 1983)).

218. *Id.* at 49.

219. *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 49 (2d Cir. 1986).

220. *Id.* at 48.

221. *Id.*

222. *Id.*

223. *Id.*

224. *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 50 (2d Cir. 1986).

225. *Id.*

b. Third Circuit Approach: *Midway Mfg. Co. v. Bandai-America, Inc.*²²⁶

In *Midway Mfg. Co. v. Bandai-America, Inc.*,²²⁷ Midway brought suit against Bandai claiming that Bandai's "Galaxian" video game infringed its copyrighted video game, which was also entitled "Galaxian."²²⁸ The similarities between the disputed works consisted of an "outerspace game wherein a defendant base . . . controlled by the player, attempts to fend off attacking hordes of aliens."²²⁹ Against the black backdrop of the games appears twinkling dots, which flash on and off to create the illusion that they are moving from the top to the bottom of the screen.²³⁰

Before analyzing Midway's claim, the district court stated that copyright infringement involves a two-prong analysis: (1) whether defendant copied the plaintiff's work; and (2) whether there is substantial similarity between the two works such that copying went so far as to constitute improper appropriation.²³¹ Relying upon the Third Circuit's opinion in *Universal Athletic Sales Co. v. Salkend*,²³² the court further noted that the concept of substantial similarity is applicable in both prongs of the infringement analysis.²³³

The chief difference in the dual uses of substantial similarity stems from the type of inquiry permissible in each.²³⁴ More specifically, the court emphasized that expert testimony and dissection are proper for establishing substantial similarity as an element of copying.²³⁵ Conversely, such assistance is generally disfavored for the determination of substantial similarity as proof of improper appropriation.²³⁶ Despite these findings, the court recognized that the ordinary observer test, employed for the determination of improper appropriation, "must ascend into detail where necessary to distill the protectable elements of a work."²³⁷

An examination of the works under the two-prong test revealed sev-

226. 546 F. Supp. 125 (D.N.J. 1982).

227. *Id.*

228. *Id.* at 125.

229. *Id.* at 144.

230. *Id.* at 138.

231. *Midway Mfg. Co. v. Bandai-America, Inc.*, 546 F. Supp. 125, 138 (D.N.J. 1982) (citing *Universal Athletic Sales Co. v. Salkend*, 511 F.2d 904, 907 (3d Cir.), *cert. denied*, 423 U.S. 863 (1975)).

232. 511 F.2d 904 (3d Cir. 1975).

233. *Midway Mfg. Co. v. Bandai-America, Inc.*, 546 F. Supp. 125, 138 (D.N.J. 1982).

234. *Id.*

235. *Id.* (citing *Universal Athletic*, 511 F.2d at 907).

236. *Id.*

237. *Midway Mfg. Co. v. Bandai-America, Inc.*, 546 F. Supp. 125, 153 n.40 (D.N.J. 1982).

eral similarities between the works. First, the musical themes of the two Galaxian games were fundamentally identical.²³⁸ Second, Bandai's insect characters bore a close resemblance to Midway's since both have bright eyes and two-toned bodies.²³⁹ Lastly, both games have a background of twinkling stars set against black space.²⁴⁰ Based on the foregoing similarities, the court held that Midway was entitled to a directed verdict on the issue of "copying."²⁴¹

Conversely, the court declined to enter summary judgment in favor of Midway on the issue of unlawful appropriation.²⁴² This declination was based on the principle that "to direct a verdict for [the] plaintiff on this issue, the works must be virtually identical."²⁴³ This identity between the works was not sufficiently demonstrated by Midway. Accordingly, the court held that "the Galaxian claim must go to the trier of fact . . . on the issue of whether an ordinary lay observer would detect such a substantial similarity between the two works as to show the copying went so far as to constitute improper appropriation."²⁴⁴

c. Seventh Circuit Approach: *Stillman v. Leo Burnett Co.*²⁴⁵

Finally, in *Stillman v. Leo Burnett Co.*,²⁴⁶ Michael Stillman ("Stillman") brought a copyright infringement suit against the defendants alleging that they copied a silent television commercial he created for Eastern Airlines ("Eastern").²⁴⁷ This controversy began in 1986, after Eastern Airlines opted not to use Stillman's silent commercial for its American market.²⁴⁸ Thereafter, Stillman wrote to United Airline's ("United") president suggesting that United engage Stillman to produce silent commercials for United's American market.²⁴⁹ Along with the letters, Stillman enclosed copies of the Eastern storyboard.²⁵⁰ Although United never hired Stillman, they aired a silent television commercial in 1987, almost identical to Stillman's.²⁵¹ United's commercial, like Still-

238. *Id.* at 146.

239. *Id.*

240. *Id.* at 146-47.

241. *Id.* at 147.

242. *Midway Mfg. Co. v. Bandai-America, Inc.*, 546 F. Supp. 125, 149 (D.N.J. 1982).

243. *Id.*

244. *Id.*

245. 720 F. Supp. 1353 (N.D. Ill. 1989).

246. *Id.*

247. *Id.* at 1355.

248. *Id.* at 1356.

249. *Id.*

250. *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1356 (N.D. Ill. 1989).

251. *Id.*

man's, employed silence as a means of attracting the viewers' attention.²⁵² Both commercials "contained nine screens, the first eight of which were black with white reverse-type writing fading in and out from screen to screen . . ."²⁵³ Nevertheless, Leo Burnett maintained that the creation of its silent commercial resulted from "lucky inspiration."²⁵⁴

According to the *Stillman* court, a plaintiff may prevail on a copyright infringement claim by proving: (1) a valid copyright and (2) illicit copying.²⁵⁵ To establish illicit copying, the plaintiff must demonstrate both copying and unlawful appropriation.²⁵⁶ The defendants in *Stillman* conceded that the plaintiff owned a valid copyright²⁵⁷ and that they had copied the basic concept from the plaintiff's work.²⁵⁸ As a result, the threshold inquiry was whether the defendants were entitled to summary judgment because they did not appropriate protectable material from the plaintiff's work.²⁵⁹ To determine if the defendants were entitled to summary judgment, the *Stillman* court deemed analytic dissection of the works appropriate to determine if "at least some of what defendant copied falls into the area of protectible expression."²⁶⁰

The defendants contended that their copying of Stillman's use of an opening screen stating that the commercial is silent was necessary to the expression of a silent commercial.²⁶¹ Because silent commercials can only be expressed in this stereotyped form, the defendants maintained that such similarity could not constitute copyright infringement.²⁶² While the *Stillman* court agreed with the principles espoused by defendants, it nonetheless took the analysis one step farther.²⁶³ In particular, the court found that copyright protection does extend to the creative ar-

252. *Id.* at 1355.

253. *Id.* at 1356.

254. *Id.*

255. *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1358 (N.D. Ill. 1989).

256. *Id.*

257. *Id.* at 1356. In 1988, Stillman obtained a certificate of registration for his silent commercial from the United States Registration of Copyrights. *Id.*

258. *Id.*

259. *Id.*

260. *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1360 (N.D. Ill. 1989). See also *Nash v. Columbia Broadcasting Sys.*, 704 F. Supp. 823, 829 (N.D. Ill. 1989) (The court modified the Seventh Circuit test here to reflect the current Second Circuit test for substantial similarity. In particular, the determination of substantial similarity necessary to prove defendant's unlawful appropriation is broken down into two steps: First, the court must determine whether there has been copying of protectable expression. If this is found, the court must further determine if the copied portions of protected expression are so extensive to constitute unlawful appropriation). *Id.*

261. *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1360 (N.D. Ill. 1989).

262. *Id.*

263. *Id.*

rangement and interaction of otherwise unprotectable elements.²⁶⁴ Therefore, the court concluded that, where a jury determines that defendants copied plaintiff's work in making their commercial, and in doing so, created a commercial which evokes a similar response in the ordinary observer, then defendants invaded protectable expression, and infringement should be found.²⁶⁵

d. The Ninth Circuit: *Aliotti v. R. Dakin & Co.*²⁶⁶ and *Olson v. National Broadcasting Co.*²⁶⁷

Although the Ninth Circuit has not adopted the recommended alternative approach for copyright infringement actions, recent opinions demonstrate the Circuit's acceptance of the modified audience test employed therein. In *Aliotti v. R. Dakin & Co.*,²⁶⁸ the Ninth Circuit modified the *Krofft* intrinsic test as follows:

To the extent that it is necessary to determine whether similarities result from unprotectable expression, it is appropriate under *Krofft's* intrinsic test to perform analytic dissection of similarities [N]o substantial similarity may be found under the intrinsic test where analytical dissection demonstrates that all similarities in expression arise from the use of common ideas.²⁶⁹

Similarly, in *Olson v. National Broadcasting Co.*,²⁷⁰ Ernest Olson, the author of the television series pilot *Cargo*, brought this infringement action against the producers' of the television series, *The A-Team*.²⁷¹ Both works were action-adventure series designed to portray Vietnam veterans in a positive light.²⁷² In reviewing Olson's claim, the Ninth Circuit determined that while a reasonable jury might have found substantial similarity in the total concept and feel of the works, "no substantial similarity may be found under the intrinsic test where analytic dissection demonstrates all similarities [in expression] arise from the use of common ideas."²⁷³ Again, analytic dissection was necessary to ensure that the intrinsic comparison does not consider unprotectable forms of ex-

264. *Id.*

265. *Id.* at 1361.

266. 831 F.2d 898 (9th Cir. 1987).

267. 855 F.2d 1446 (9th Cir. 1988).

268. 831 F.2d 898 (9th Cir. 1987).

269. *Id.* at 901 (emphasis omitted).

270. 855 F.2d 1446 (9th Cir. 1988).

271. *Id.* at 1447-48.

272. *Id.* at 1450.

273. *Id.* at 1453 (quoting *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987)).

pression.²⁷⁴ The only similarities found to exist between plaintiff's *Cargo* and defendants' *A-Team* were "common to the genre of action-adventure television series and movies"²⁷⁵ and thus constituted unprotectable scènes à faire.²⁷⁶ Consequently, the court concluded that no substantial similarity may be found under the intrinsic test.²⁷⁷

VII. CONCLUSION

For decades, American courts have struggled to create workable tests for deciding copyright infringement suits. In their quest for the "ultimate" test, most courts have recognized the importance of distinguishing the separate forms of substantial similarity to decide infringement actions. In addition, these courts have acknowledged that any workable standard for determining infringement must serve the divergent goals of copyright law.

Originally, in *Krofft*, the Ninth Circuit developed a two-part test for substantial similarity that distinguished between similarities of ideas, on the one hand, and similarities in the expression of those ideas on the other. This particular use of the idea-expression distinction nevertheless fails to provide the analytic basis needed to distinguish substantial similarity as an element of copying from substantial similarity as an element of unlawful appropriation. Consequently, the Ninth Circuit only compounded the distortion surrounding these separate forms of substantial similarity in *Shaw*²⁷⁸ when it enunciated a new test for substantial similarity based upon *Krofft*. By limiting the plaintiff's burden of proof to substantial similarity under the extrinsic test, the *Shaw* test essentially eliminates any recognition of the dual significance of substantial similarity.

The vast array of copyrighted works and the particular interests at stake today call for a flexible yet precise framework for determining copyright infringement. It is important that individual authors know how a court will apply a settled principle, such as the test for infringement, so that the individual can determine the scope of his or her copyright protection. Likewise, this predictability will enable the public to assess their right to employ the ideas and concepts underlying the copyrighted work to create their own copyrightable work. The rule enunciated

274. *Id.*

275. *Olson v. National Broadcasting Co.*, 855 F.2d 1446, 1451 (9th Cir. 1988).

276. *Id.* at 1453.

277. *Id.*

278. 908 F.2d 531 (9th Cir. 1990).

ated in *Shaw* is far too susceptible to subjective determinations of copyright infringement.

Therefore, the time has undoubtedly arrived for the Ninth Circuit to establish a new approach to copyright infringement actions, such as the alternative approach recommended above. The alternative approach will preserve the integrity of copyright law by providing the Ninth Circuit with a more efficient and workable framework for adjudicating infringement suits. Similar approaches recently employed by the Second, Third and Seventh Circuits demonstrate the clarity and precision that the alternative approach contributes to the infringement determination. Had the Ninth Circuit employed the alternative approach to *Shaw*'s copyright infringement action, it would have achieved the same results in a more precise and consistent manner. It is hoped that the Ninth Circuit will soon realize that its modified *Krofft* approach only frustrates the infringement determination, and thereby acknowledge that an entirely new approach is in order.

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